



Paper No. 12

RONALD C. CARD
BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP
12400 WILSHIRE BOULEVARD, 7TH FLOOR
LOS ANGELES, CA 90025

COPY MAILED

OCT 2 1 2002

OFFICE OF PETITIONS

In re Application of
Gruner et al.
Application No. 09/385,927
Filed: August 30, 1999
Attorney Docket No. 42390.P7268

:
: DECISION GRANTING PETITIONS
: AND ACCORDING STATUS UNDER
: 37 CFR 1.47(a)
:

This decision concerns the 37 CFR 1.47(a) petition filed on July 22, 2002, and the October 29, 1999 "Request for Correction of Filing Receipt" which is being properly treated as a petition under 37 CFR 1.10(c).

The petition under 37 CFR 1.47(a) is **GRANTED**.
The petition under 37 CFR 1.10(c) is **GRANTED**.

Petition under 37 CFR 1.47(a)

Three inventors are named in this application which, upon filing, included an un-executed declaration. The declaration subsequently submitted on February 22, 2000 was signed by only 2 inventors. A January 15, 2002 non-final Office Action provided a shortened statutory period for the submission of, *inter alia*, a proper oath/declaration. In response, the instant petition was filed, requesting that the 2 signing inventors be allowed to make this application on behalf of themselves and the remaining inventor, Mike Morrison ("Morrison"), who allegedly refuses to join in this application.

The 2 signing inventors may file this application on behalf of themselves as well as Morrison, provided that a *bona fide* attempt has been made to present to Morrison, for signature, a copy of the **entire application (specification including claims; drawings)**,¹ and that Morrison refuses to join in this application. To show that Morrison has refused to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a statement of facts concerning the circumstances of the presentation of the application papers to Morrison at his last known address,² and his subsequent refusal.³

¹ MPEP section 409.03(d) (Aug. 2001) REFUSAL TO JOIN.

² 37 CFR 1.47(a); also see MPEP section 409.03(e) (Aug. 2001).

³ See MPEP section 409.03(d) (Aug. 2001) (Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . . When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.).

The instant petition is supported by a declaration of Ronald C. Card, counsel for the assignee-of-record for this application ("Card") ("Card Declaration"), in essence setting forth that:

- (1) on numerous occasions, Card had left messages for Morrison at both his home and work telephone numbers, but Morrison never returned the calls;
- (2) on February 9, 2000, Card sent Morrison a copy of the "patent application" for review; and that
- (3) as of July 14, 2002, when the Card Declaration was executed, Card has not heard from Morrison regarding the application.

The Card Declaration indicates that counsel had made a reasonably diligent effort in reaching Morrison before concluding that Morrison refused to join in this application. The §1.47(a) petition is thus granted.⁴ Receipt of the \$130 petition fee is acknowledged.

The application is now complete.

Petition under 37 CFR 1.10(c)⁵

This petition requests that the application be accorded a filing date of August 30, 1999, on the basis that the application was deposited in the U.S. Postal Service (USPS) "Express Mail Post Office to Addressee" service ("Express Mail") on that day rather than on August 28, 1999, the presently accorded filing date.

In support, the petition encloses a copy of the "Express mail" mailing label bearing the number EL 431892167US and containing an official USPS date-stamp of August 30, 1999. Moreover, the transmittal form for the originally filed application, which itemizes the application papers being mailed on August 30, 1999, includes the same number. The petition is thus granted. No fee is required for petitions under 37 CFR 1.10.

As provided in 37 CFR 1.47(c), the Office will forward notice of the filing of this application to Morrison at his last known address provided in the petition:

3131 Homestead Road, #10-J
Santa Clara, CA 95051

Notice of the filing of this application will also be published in the *Official Gazette*.

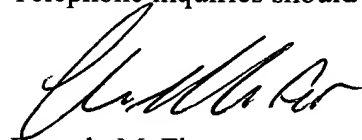
⁴ This conclusion is based on the assumption that the copy of "patent application" sent to Morrison on 2/9/00 included the specification (with claims) and the drawings. **If this assumption is incorrect, counsel must notify this Office upon receipt of this Decision.**

⁵ Under 37 CFR 1.10(c), any person filing correspondence that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, may petition the Commissioner if there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or **other official USPS notation** (emphasis added); see also MPEP section 513 (Aug. 2001).

Finally, Applicants are reminded of the outstanding final Office Action mailed on October 2, 2002, and the fact that the filing of the instant §1.47(a) petition will not toll the reply period set forth in that Office action to save the application from becoming abandoned otherwise.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 30, 1999, and for issuance of a corrected filing receipt reflecting this filing date. Thereafter, the application will be returned to Technology Center 2100 to await a response to the final Office action.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy